

FW



Docket No.: 050179-0110

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Customer Number: 20277  
Peter David EAST : Confirmation Number: 4463  
Application No.: 10/617,962 : Group Art Unit: 1638  
Filed: July 14, 2003 : Allowed: June 28, 2005  
Examiner: Anne R. Kubelik  
For: A TOXIN GENE FROM THE BACTERIA PHOTORHABDUS LUMINESCENS (As Amended)

**REQUEST FOR ACKNOWLEDGEMENT OF THE CITED ART**

Mail Stop ISSUE FEE  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant is in receipt of the Notice of Allowance dated June 28, 2005.

In reviewing the file, it is noted that we have not received acknowledgement of the Information Disclosure Statement and cited art filed July 14, 2003, which references were cited or submitted in the parent application under 37 CFR 1.98(d). Enclosed are copies of the Information Disclosure Statement, PTO-1449 and stamped return postcard acknowledgement.

Applicant hereby respectfully requests that:

- (1) the appropriately acknowledged PTO-1449 be furnished to Applicant; and
- (2) the record be clarified to confirm that the cited art has been considered and made of record.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Kelli N. Watson  
Registration No. 47,170

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 KNW:cg  
Facsimile: 202.756.8087  
**Date: July 14, 2005**

**Please recognize our Customer No. 20277 as our correspondence address.**

Applicant: Peter David EASTDocket No. 50179-110Title: TOXIN GENES FROM THE BACTERIA XENORHABDUS NEMATOPHILUS AND PHOTORHABDUS LUMINESCENS

Serial/Reg./Patent No. \_\_\_\_\_

Date Sent: 7/14/2003☒ Hand Carried☐ Fax☐ Electronic☐ Cert. of Mailing☐ Express Mail No. \_\_\_\_\_☒ Transmittal Letter

New Patent App

☐ Utility☐ Design☒ Cont.☐ CIP☐ Div.☐ PCT☐ RCE☐ Prov☐ Other: \_\_\_\_\_32 pages of Specification3 pages of Claims

\_\_\_\_\_ pages of Abstract

9 pages of Formal/Informal Drawings☐ Small Entity☐ Large Entity☐ Declaration/Power of Attorney☐ Recordation of Assignment/Security Agreement☒ Information Disclosure Statement

\_\_\_\_\_ Form PTO 1449

\_\_\_\_\_ copies of cited references

☒ Preliminary Amendment☐ Response to Missing Parts Notice☐ Resp. to Notice to Correct App. Papers☐ Certified Copy of Priority Doc.☐ Claim for Convention Priority☐ Response/Amendment to Office Action of \_\_\_\_\_☐ Request for \_\_\_\_\_ month Extension of Time☐ Letter submitting \_\_\_\_\_ pages of drawings☐ Req. for Approval of Drawing Amendments☐ Req. for Oral Hearing☐ Not. of Appeal ☐ Appeal Brief☐ Reply Brief☐ Rule 312 Amendment/Letter☐ Req. for Acknowledgement of Cited Art☐ Issue Fee☐ Publication Fee☐ Req. for Certificate of Correction☐ Maintenance Fee for \_\_\_\_\_ years after grant☐ Fee Address Indication Form☐ Terminal Disclaimer☐ Petition to Commissioner☐ Status Inquiry☒ Other Correspondence Address Change

17058 U.S. PTO

10/617962



07/14/03

HOLD FOR  
SERIAL # \_\_\_\_\_

Check for \$	<input checked="" type="checkbox"/> Charge Deposit Acct. 500417\$	750.00	Atty Init.	RLP	Tkpr. #	4231	Secy. or PL:	BPatrick
--------------	---	--------	------------	-----	---------	------	--------------	----------

CMS Descrip.: (1) 750.00

THE PATENT AND TRADEMARK OFFICE DATE STAMPED HEREON IS ACKNOWLEDGEMENT THAT THE ITEMS, CHECKED ABOVE, WERE RECEIVED BY THE PTO ON THE DATE STAMPED.

Docket No.: 50179-110

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Peter David EAST

Serial No.: Continuation of Appln.

Serial No. 09/463,048

: Group Art Unit: Not yet assigned

Filed: July 14, 2003

: Examiner: Not yet assigned

For: TOXIN GENES FROM THE BACTERIA XENORHABDUS NEMATOPHILUS AND  
PHOTORHABDUS LUMINESCENS

**INFORMATION DISCLOSURE STATEMENT**

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with the provisions of 37 C.F.R. 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached form PTO-1449. It is respectfully requested that the references be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

This Information Disclosure Statement is being filed within three months of the U.S. filing date OR before the mailing date of a first Office Action on the merits. No certification or fee is required.

The references were cited by or submitted to the U.S. Patent and Trademark Office in parent application Serial No. 09/463,048, filed April 4, 2000, which is relied upon for an earlier filing date under 35 USC 120. Thus, copies of these references are not attached. 37 CFR 1.98(d).

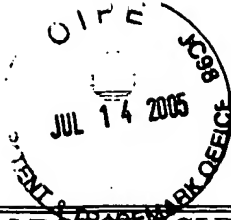
Respectfully submitted,  
MCDERMOTT, WILL & EMERY

*Robert L. Price* REG. NO. 39,048

FOR

Robert L. Price  
Registration No. 22,685

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 RLP:blp  
Facsimile: (202) 756-8087  
Date: July 14, 2003



SHEET 1 OF 1

INFORMATION DISCLOSURE  
CITATION IN AN  
APPLICATION

(PTO-1449)

ATTY. DOCKET NO.  
**50179-110**SERIAL NO.  
**Continuation of Appln.  
Serial No. 09/463,048**APPLICANT  
**Peter David EAST**FILING DATE  
**July 14, 2003**GROUP  
**Not yet assigned**

## U.S. PATENT DOCUMENTS

EXAMINER'S INITIALS	CITE NO.	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		US 5,972,687	10/1999	Smlglelski	
		US			
		US			
		US			

## FOREIGN PATENT DOCUMENTS

EXAMINER'S INITIALS	CITE NO.	Foreign Patent Document Country Codes - Number - Kind Codes (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines Where Relevant Figures Appear	Translation	
						Yes	No
		WO 95/00647	1/95				
		PCT 0142924	9/84				
		WO 97/17432	5/97				

## OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER'S INITIALS	CITE NO.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
		B. Brunel et al., Fast and Accurate Identification of <i>Xenorhabdus</i> and <i>Photorhabdus</i> Species by Restriction Analysis of PCR-Amplified 16S rRNA Genes, Applied and Environmental Microbiology, Vol. 63, Feb, 1997, pp. 574-580.
		S. Henikoff, Unidirectional Digestion with Exonuclease III Creates Targeted Breakpoints for DNA Sequencing, Gene, Vol. 28, 1984, pp. 351-359.
		M.A. Innis et al., PCR Protocols: A guide to Methods and Applications, Academic Press, Inc. 1990, pp. 3-20.
		J. Mamur, A procedure for the Isolation of Deoxyribonucleic Acid from Micro-organisms, J. Mol. Biol., Vol. 3, 1961, pp. 208-218.
		K. F. Scott et al., Biological Nitrogen Fixation: Primary Structure of the <i>Klebsiella Pneumoniae</i> <i>nifH</i> and <i>nifD</i> Genes, Journal of Molecular and applied Genetics, Vol. 1, pp. 71-81.
		Lazar et al., Transforming growth factor a: mutation of aspartic acid 47 and leucine 48 resulted in different biological activities, March 1988, pp. 1247-1252, Vol. 8, No. 3.
		Bowie et al., Deciphering the message in protein sequences: tolerance to amino acid substitutions Science, Vol. 247.
		Jouanin et al., Transgenic plants for insect resistance Plant Science 131 1998 1-11.
		Smigocki et al., cytokinin-mediated insect resistance in Nicotiana plants transformed with the pit gene 23: 325-335 1993.
		Pang et al., Expression of a gene encoding a scorpion insectotoxin peptide in yeast, bacteria and plants Gene 116 1992 165-172.
		Broun et al., Catalytic plasticity of fatty acid modification enzymes underlying chemical diversity of plant lipids, Science Vol. 282, Nov. 13, 1998.
		Hongsthong et al., "Optimum conditions for insecticidal toxin production by <i>Photorhabdus luminescens</i> " Abstracts of the General Meeting Of The American Society for Microbiology, The Society, Washington, D.C., US, No. 95, 1 May 1995, pp. 408-AbstrQ-48, XP002076055 ISSN: 1060-2011.

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.



SHEET 2 OF 2

INFORMATION DISCLOSURE  
CITATION IN AN  
APPLICATIONATTY. DOCKET NO.  
50179-110SERIAL NO.  
Continuation of Appln.  
Serial No. 09/463,048APPLICANT  
Peter David EASTFILING DATE  
July 14, 2003GROUP  
Not yet assigned

(PTO-1449)

## U.S. PATENT DOCUMENTS

EXAMINER'S INITIALS	CITE NO.	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		US			
		US			
		US			
		US			

## FOREIGN PATENT DOCUMENTS

EXAMINER'S INITIALS	CITE NO.	Foreign Patent Document Country Codes - Number - Kind Codes (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines Where Relevant Figures Appear	Translation	
						Yes	No

## OTHER ART (Including Author, Title, Date, Pertinent Pages, Etc.)

EXAMINER'S INITIALS	CITE NO.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	
		Bowen D J et al., "Extracellular Insecticidal Factor Produced By Xenorhabdus luminescens" Abstracts Of The Annual Meeting Of The American Society For Microbiology, Washington, DC, US, Vol. 90, 1989, page 228 XP002119858 ISSN: 0094-8519.	
		Clarke David J. et al., "Virulence mechanism of Photobhabdus sp. strain K122 toward wax moth larvae." Journal Of Invertebrate Pathology, Vol. 66, No. 2, 1995, pp. 149-155, XP001064286 ISSN: 0022-2011	
		Hu, K. et al., "Mortality Of Plant-Parasitic Nematodes Caused By Bacterial (Xenorhabdus Spp. and Photobhabdus Luminescens) Culture Media" Journal Of Nematology, Society of Nematologists, College Park, MD, US, Vol. 27, No. 4, 1995, pp. 502-503, XP000905673 ISSN: 0022-300X.	
		David Joseph Bowen, "Characterization Of A High Molecular Weight Insecticidal Protein Complex Produced By The Entomopathogenic Bacterium Photobhabdus Luminescens (Nematodes, Biological Control)", Thesis University Wisconsin, XX, XX, 1 May 1995, XP002076022.	

EXAMINER

DATE CONSIDERED

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.